1.98(a)(3) and has not been considered. However, Applicants did not file an Information Disclosure Statement on that date. Nonetheless, as discussed in the previous Amendment, Applicants filed an Information Disclosure Statement citing three co-pending applications, all of which are in English, on February 17, 2000. Thus, 37 CFR 1.98(a)(3), which requires a concise statement of relevance of any document not in the English language, is inapplicable. Accordingly, consideration of the information contained in the Information Disclosure Statement filed February 17, 2000 is again respectfully requested.

Applicants respectfully request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-5, 7-15, and 17 are pending in the present application. Claims 1, 10, and 17 are the independent claims.

Claims 1, 10, and 17 have been amended. No new matter is believed to have been added.

By the present amendment, Applicants have amended the title in a manner believed to even better describe the claimed subject matter. Favorable consideration is respectfully requested.

Claims 1-9 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner contends that the disclosure does not teach structural support for the "selecting means" and "input means" features of independent Claim 1. In response, attention is directed to at least Figures 1 and 2 and page 9, line 7 - page 15, line 17 of the specification where an overall arrangement of a purchase request system according to the present invention and a personal computer that can be used with such a system are illustrated and discussed. Applicants respectfully submit that the

claims fully satisfy the requirements of 35 U.S.C. § 112, second paragraph and favorable reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1, 4, 7-10, 13-15, and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,870,717 (Wiecha) in view of U.S. Patent No. 5,694,551 (Doyle, et al.). Claims 2, 3, 11, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weicha and Doyle in view of U.S. Patent No. 5,500,513 (Langhans, et al.). Claims 2-5, 12, and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weicha and Doyle in view of U.S. Patent No. 5,970,475 (Barnes, et al.). These rejections are respectfully traversed.

Independent Claim 1 recites, inter alia, purchase approving means for, when information representing approval of purchase of a selected article is input, storing the inputted information in a database and deleting from displayed items associated with articles displayed by a display means, displayed items associated with the approved article. Independent Claims 10 and 17 correspond generally to independent Claim 1 and recite similar features in method and computer-readable storage medium forms, respectively.

By the aforementioned feature, a user who approves or rejects purchase requests can more easily understand the present status of approval-requested articles and can quickly decide whether to approve or reject the purchase of same. Thus, approval or rejection of a purchase-requested article can be made more efficiently.

However, Applicants respectfully submit that none of Wiecha, Doyle, et al., Langhans, et al., or Barnes, et al., alone or in combination (assuming, arguendo, that the documents could be combined) disclose or suggest at least the above-discussed claimed feature as recited in independent Claims 1, 10, and 17.

The Office takes the position that Wiecha teaches "deleting of a line item once an order has been placed with a vendor. . . ." (Office Action, page 3). Applicants respectfully disagree.

Wiecha relates to a system for ordering items over a computer network using an electronic catalog and teaches that a line item in a "product clip board" can be deleted after an order has been placed. (Col. 9, line 1; Col. 10, line 3). However, the Wiecha line items are transmitted to approvers as purchase orders in response to an employee's selection of a "Submit" icon. (Col. 3, lines 29-38). Thus, Wiecha teaches deleting line items relating to "placed" or "submitted" orders. In contrast to Wiecha, the independent claims recite that displayed items associated with the approved article can be deleted when information representing approval of purchase of the selected subject article is input.

Nonetheless, the Office still rejects independent Claims 1, 10, and 17 because the Office argues that aforementioned feature is inherent to Wiecha since "Wiecha teaches deleting of a line item once an order has been placed with a vendor. Therefore, the input of information representing approval of the purchase is inherent in the system and method of Wiecha ...." (Office Action, page 6). However, Applicants submit that regardless of whether the input of information representing approval of the purchase is inherent, the input of such information does not mean that line items in Wiecha are deleted in response to the input of information representing approval of a purchase. Rather the Office's position is fatally flawed because Wiecha expressly teaches that the deletion of line items is in response to the submission of a purchase order. Indeed, as the Office admits, "Wiecha teaches deleting of a line item once an order has been placed with a

vendor." (Office Action, page 6). Thus, while the input of information representing approval of a selected subject may be inherent to <u>Wiecha</u>, deleting items associated with the approved article in response to the input of such information is not.

The rejection of independent Claims 1, 10, and 17 fails for another reason. MPEP § 2112 sets forth the test for satisfying the Office's burden of proof by quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) as follows:

> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." (emphasis in original)(MPEP Eighth Original Edition, page 2100-52).

Indeed, a reference inherently discloses a claim feature only if "missing descriptive matter is *necessarily* present in the thing described in the reference." <u>Finnigan Corp. v. United States Int'l Trade Comm'n</u>, 180 F.3d 1354, 1365 (Fed. Cir. 1999) (emphasis added). According to well-established law, "inherency . . . may not be established by probabilities or possibilities." <u>Id.</u> (quoting <u>Continental Can Co., U.S.A. v. Monsanto Co.</u>, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991)). As such, the mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to show inherency. In re King, 231 USPQ 136 (Fed. Cir. 1986).

Thus, to apply the inherency argument here, the Office must provide a basis in fact and/or technical reasoning to show that in response to inputting information representing approval of the purchase, <u>Wiecha</u> necessarilly teaches deleting of items associated with approved article, not once an order has been placed with a vendor. However, the basis in fact or technical reasoning asserted by the Office is merely the unsupported conclusion that the input of information representing approval of the

purchase is inherent in the system and method of <u>Wiecha</u>. But Applicants submit that such an unsupported conclusion cannot constitute the basis in fact or technical reasoning required by MPEP § 2112.

The secondary citation to <u>Doyle, et al.</u> relates to a computer integration network for channeling customer orders through a centralized computer to various suppliers and is cited for its alleged teaching of displaying a vendor's catalog of items as a list. Applicants submit that <u>Doyle, et al.</u> does not add anything to the teachings of <u>Wiecha</u> that would remedy the aforementioned deficiency.

None of the other citations of record were asserted against independent Claims 1, 10, and 17. <u>Langhans, et al.</u>, asserted against Claims 2, 3, 11, and 12, relates to an automated purchase control system in which users can purchase goods/services by selecting items stored in a database via an Internet while <u>Barnes, et al.</u>, asserted against Claims 2-5, 12, and 13, relates to an electronic procurement system and method for trading partners that includes an automatic settlement process for credit card purchases. Applicants submit that <u>Langhans, et al.</u> and <u>Barnes, et al.</u> add nothing to <u>Wiecha</u>'s teachings that would remedy the above-mentioned deficiencies.
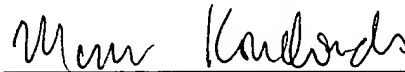
For the foregoing reasons, Applicants submit that the independent claims patentably define the present invention over the citations of record. Further the dependent claims should also be allowable for the same reasons as the base claim for which they depend and further due to the additional features that they recite. Separate and individual consideration of each dependent claim is respectfully requested.

Applicants believe the present Amendment is responsive to each of the points raised by the Examiner in the Official Action, and submits that the present

application is in allowable form. Favorable consideration of the claims and passage to issue of the present application at the Examiner's earliest convenience earnestly are solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

Attorney for Applicants
Michael E. Kondoudis
Registration No. 42,758

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO THE CLAIMS

1.   (Twice Amended) A purchase request approving apparatus capable

of approving a purchase request of a desired article, comprising:

display means for displaying items of information, the items of information

being (i) stored in a database in advance and (ii) associated with articles for which

approval of purchase is requested, in a list window capable of displaying the articles as a

list;

selecting means for selecting a desired article, in accordance with a user

operation, from the articles displayed in the list window;

input means for inputting information representing approval or rejection of

purchase of a selected article from the displayed articles; and

purchase approving means for, when information representing approval of

purchase of the selected subject article is input, storing the inputted information in the

database, and deleting from the displayed items associated with the articles displayed by

said display means, displayed items associated with the [selected] approved article.

10.   (Twice Amended) A purchase request approving method of

approving a purchase request of a desired article using a computer, said method

comprising:

a display step of displaying items of information, the items of information

being (i) stored in a database in advance and (ii) associated with articles for which

approval of purchase is requested, in a list window capable of displaying the articles as a

list;

a selecting step of selecting a desired article in accordance with a user

operation, from the articles displayed in the list window;

an input step of inputting information representing approval or rejection of

purchase of a selected article from the displayed articles; and

a purchase approving step of, when information representing approval of

purchase of the selected article is input, storing the inputted information in the database,

and deleting, from the displayed items associated with the articles displayed in said display

step, displayed items associated with the [selected] approved article.

17.   (Twice Amended) A computer-readable storage medium storing a

program for executing a purchase request approving method of approving a purchase

request of a desired article using a computer, said method comprising:

a display step of displaying items of information, the items of information

being (i) stored in a database in advance and (ii) associated with articles for which

approval of purchase is requested, in a list window capable of displaying the articles as a

list;

a selecting step of selecting a desired article in accordance with a user

operation, from the articles displayed in the list window;

an input step of inputting information representing approval or rejection of

purchase of a selected article from the displayed articles; and

a purchase approving step of, when information representing approval of

purchase of the selected article is input, storing the inputted information in the database,

and deleting, from the displayed items associated with the articles displayed in said display

step, displayed items associated with the [selected] approved article.

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